

REMARKS

Claims 271-281 are presently pending in the patent application.

1. EXAMINER INTERVIEW

An Examiner Interview was conducted on February 16, 2011, and included the undersigned, Mr. Vince Wiltse, Mr. John Blake, Mr. Curtis Hollowell, and Examiners Jamie Swartz, Kambiz Abdi, and Thomas Dixon. The office action and the prior art cited in the pending office action were discussed in relation to claims 271-272. Agreement was not reached.

2. 35 U.S.C. § 112 REJECTION

Claims 272-274, 276, 277 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Reconsideration and withdrawal are requested in view of the amendments to claims 271 and 275 herein, which are submitted to address the noted antecedent basis issues.

3. 35 U.S.C. § 103 REJECTION OF CLAIMS 271, 275-280

Claims 271, 275-280 were rejected under 35 U.S.C. 103(a) as being unpatentable over Molbak et al. (US 5620079) in view of Small (US 5513117) in further view of Geib et al. (US 6042470)(Geib). Reconsideration and withdrawal of this rejection is respectfully requested.

As an initial matter, Applicants respectfully submit that Geib is an inappropriate reference for combination with Molbak and Small, as alleged. Under 35 U.S.C. § 103(c)(1), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, *shall not preclude patentability under this section* where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person”. (emphasis added). Geib is assigned to Cummins-Allison Corp., the present assignee, and the Examiner has not shown that Geib is a 35 U.S.C. § 102(a) or 35 U.S.C. § 102(b) reference. Instead, the filing date of Geib was April 18, 1997, with a claimed

priority of January 11, 1996. The present application is a divisional of and claims priority to U.S. Application No. 08/814,978, filed March 11, 1997, which claims priority to U.S. Provisional Application Nos. 60/031,604 (filed November 27, 1996), and is a continuation-in-part of U.S. Application No. 08/664,262, filed May 13, 1996.

Accordingly, the proffered rejection fails to set forth a *prima facie* case of obviousness for at least the reason that Geib is an inappropriate reference to apply in combination with the remaining references and the remaining references fail to disclose or suggest each and every element of the rejected claims, as is acknowledged by the Examiner.

Further, regarding claims 271, 275, and 278, Molbak was alleged to teach, *inter alia*, “storing to a card a monetary value that is related to a total value” (*citing* col. 6, lines 6-20, col. 2, lines 30-60) and “dispensing said card from the self-service machine” (*citing* col. 4, line 59 - col. 5, line 2). These assertions are incorrect, as Molbak fails to disclose these features alleged by the Examiner to be disclosed therein. Instead, the cited passages of Molbak, and the balance of Molbak, disclose a “voucher” dispensing machine that comprises a paper voucher on which is printed certain information (see, e.g., col. 10, line 64 to col. 11, line 2, disclosing that the voucher printer preferably comprises “a thermal printing system, laser printing system, inkjet system, or the like”). Molbak fails to disclose, *inter alia*, “storing to a card a monetary value that is related to a total value,” “dispensing said card from the self-service machine,” and/or “selecting a card from a plurality of cards that are not associated with any value, storing on a storage medium of said card a monetary value that is related to said total value, and dispensing said card from the self-service machine.

Molbak was acknowledged not to disclose “selecting a card from a plurality of cards” and, for this failing, the Examiner relied on Small as teaching “selecting a card from a plurality

of cards that are not associated with any value” (*citing* col. 6, lines 6-20, col. 2, lines 30-60). However, Small relates to a “automated vending apparatus for simultaneously dispensing personalized greeting cards and electronically vendable gifts” (col. 2, lines 30-31). The ability to select a card from a plurality of cards relates merely to selections from a card for a birthday, a wedding, Christmas, etc. (see FIG. 5)(reproduced below).

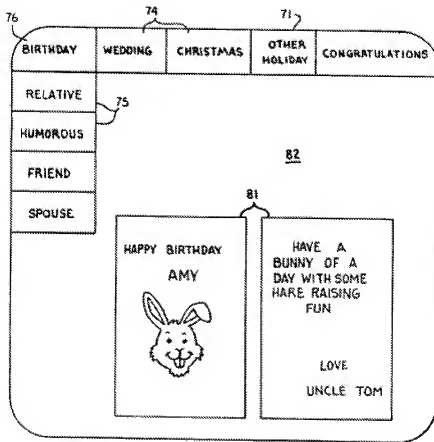
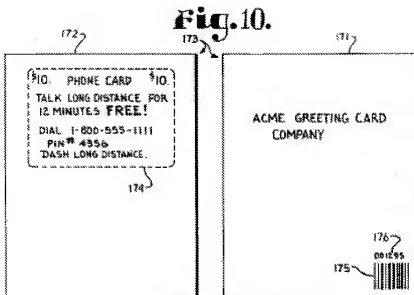
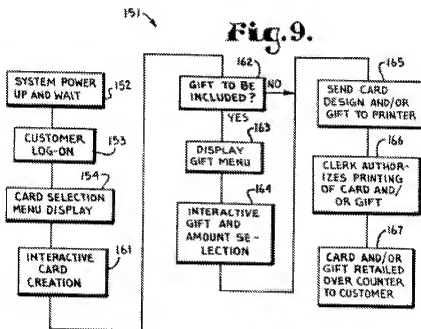


Fig. 5.

The only card having a storage medium to which a value could be stored is a telephone calling card (see FIG. 10)(reproduced below).



However, FIG. 9 (reproduced below) shows that the telephone gift card is to be provided to a customer over the counter after the clerk has authorized printing of the greeting card (see also col. 10, lines 12-20). The machine 1 of Small does not dispense cards having a monetary value related to the total value stored on a storage medium of the card.



Accordingly, Small fails to disclose or suggest, *inter alia*, “storing to a card a monetary value that is related to a total value,” “dispensing said card from the self-service machine,” and/or “selecting a card from a plurality of cards that are not associated with any value, storing on a storage medium of said card a monetary value that is related to said total value, and dispensing said card from the self-service machine” and fails to make up for the deficiencies of Molbak. Geib, even were it or a like reference to be applied in its place, itself has not been shown to disclose these features. Accordingly, for at least this reason, the Examiner has failed to show a combination of references that discloses each element of the claimed invention.

Yet further, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). Distilling the invention down to the “gist” of an invention disregards the requirement of analyzing the subject matter “as a whole”. The case law has cautioned against focusing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of *the claimed invention as a whole*, as § 103 and *Graham v. Deere* require. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 93 (Fed. Cir. 1986).

Among the Examiner’s erroneous or unsupported factual assertions and improper conclusion(s) drawn therefrom, it is submitted that the Examiner’s statement that “applying the ability to purchase a card through the kiosk of Molbak would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow the users of Molbak to receive a more robust document for the storage of their currency and not merely a paper voucher” and that “[a] card voucher would allow the funds to be carried more security” are

conclusory and are not supported by Molbak or the remainder of the applied references. Molbak instead discloses that “[t]he present invention offers a valuable service to the retailer in whose store this machine is placed as well as to the actual user” as “most customers are likely to purchase goods at the store where they exchange their coins” (col. 2, lines 47-60). Molbak further cites as an “advantage” that “a user will receive a combination of both a voucher which can be spent by the shopper on store merchandise,” noting further that “[t]ypically, the shopper will conduct the coin counting operation prior to doing shopping and thus the shopper will be armed with both an incentive for purchasing items in the store and the wherewithall (in the form a ‘spendable’ voucher) to do so.” (col. 23, lines 25-35). Yet further, as to the “security” assertion set forth by the Examiner, Molbak discloses that “[p]rinter 270 is used to print the cash vouchers and the store coupons” and that “[b]esides containing the amount of the voucher, the voucher will also contain other information such as store name, transaction number, bar codes, etc in order to make counterfeiting difficult” and that “[s]pecial papers and inks can also be used to discourage counterfeiting.” (col. 20, lines 10-20). Molbak further discloses that “[t]he printing of various information on the voucher 1910 and the recording of various information about the transaction 1920 serve a number of useful functions” such as that “[p]roviding information on the voucher gives the user an extra opportunity to verify accuracy and/or acceptability of the count and, potentially, detect any malfunctions that may have occurred” and that “[t]he information is also useful to store personnel in verifying accuracy and authenticity of the voucher.” (col. 15, lines 48-55). Continuing, Molbak discloses that “[s]tore personnel may be able to detect an inaccurate or unauthentic voucher if, for example, the voucher indicates a transaction time during which the store was not open, or indicates similar inconsistencies” (col. 15, lines 55-62).

Thus, contrary to the Examiner's assertions, Molbak discloses an inexpensive and arguably secure voucher that a user would redeem shortly after issuance. In other words, there is no evidence that the Molbak system requires or suggests a need for a "more robust document". Papers, such as receipts shoved into billfolds, wallets, or pockets, are sufficiently robust to last significant periods of time. The voucher of Molbak is perfectly sufficient to perform its function of remaining in existence during shopping and until the user reaches the checkout line, where it can be redeemed. Further, one skilled in the art would be *disinclined* to add new equipment corresponding to such card dispensers to the device of Molbak, as such new equipment would unnecessarily increase the cost of the machine and decrease profits. A general principle that touches many facets of life, including design, was voiced by the 14th century philosopher William of Occam: "Multiplicity ought not to be posited without necessity." (Occam's razor). One of ordinary skill in the art is not going to unnecessarily multiply components in a device, such as that of Molbak, simply because it could be done. There must be a rational and compelling reason to make it so. "While the analysis under 35 U.S.C. § 103 allows flexibility in determining whether a claimed invention would have been obvious obvious, KSR ...it still requires showing that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Ex Parte Subramanyam* (BPAI March 29, 2010).

As to the Examiner's numerous pronouncements of "predictability," predictability, as discussed in *KSR*, encompasses the expectation the prior art elements are not only capable of being combined, but as well that there is the expectation that the combination would have worked for its intended purpose and that there is a cogent rationale for such combination. In *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314 (Fed. Cir. 2009), for example, the court stated that an inference that a claimed combination would *not* have been

obvious is especially strong where the prior art's teachings undermine the very reason being proffered as to why a person of ordinary skill would have combined the known elements. As but one example, in the present case Molbak discloses the advantages of having a printed medium wherein the user can themselves *verify* the amount printed on the voucher for accuracy and/or acceptability and to potentially detect any defect that may have occurred (see col. 15, lines 50-55). This professed advantage is entirely lost if a "card" is printed. Yet further, a card would render Molbak unsuitable for its intended purpose, which is to dispense vouchers. Molbak's own expert, Peter Abell, in prosecution of related cases (e.g., 07/940,931, to which priority is claimed), set forth a definition of "voucher" in a Declaration submitted December 20, 1995, that "to those of skill in the art, referred to an item bearing an indication of an amount and which entitles the recipient to exchange it for cash, or for use, in the same amount, in purchasing any desired products" and that "[a] voucher is not limited to a particular product or group of products and can be for any amount, is not for certain predetermined amounts and is not limited to particular denomination or total amounts." Molbak's expert provided an example of a "voucher" (reproduced below), highlighting these characteristic features of a voucher.



Thus, one of ordinary skill in the art, as well as Molbak, would not view the proffered modification to Molbak as an “obvious” combination for at least the reason that it would eviscerate the purported benefits of Molbak.

Reconsideration and withdrawal of this 35 U.S.C. § 103 rejection is requested for at least the above-noted reasons.

4. 35 U.S.C. § 103 REJECTION OF CLAIM 272

Claim 272 is rejected under 35 U.S.C. 103(a) as being unpatentable over Molbak et al. (US 5620079) in view of Small (US 5513117) in further view of Geib et al. (US 6042470) in further view of Avnet et al. (US 5291003). Reconsideration and withdrawal of this rejection is respectfully requested.

As an initial matter, Applicants respectfully submit that Geib is an inappropriate reference for combination with Molbak and Small, as alleged. Under 35 U.S.C. § 103(c)(1), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, *shall not preclude patentability under this section* where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person”. (emphasis added). Geib is assigned to Cummins-Allison Corp., the present assignee, and the Examiner has not shown that Geib is a 35 U.S.C. § 102(a) or 35 U.S.C. § 102(b) reference. Instead, the filing date of Geib was April 18, 1997, with a claimed priority of January 11, 1996. The present application is a divisional of and claims priority to U.S. Application No. 08/814,978, filed March 11, 1997, which claims priority to U.S. Provisional Application Nos. 60/031,604 (filed November 27, 1996), and is a continuation-in-part of U.S. Application No. 08/664,262, filed May 13, 1996. Accordingly, the proffered rejection fails to set forth a prima facie case of obviousness for at least the reason that Geib is an inappropriate reference to apply in combination with the remaining references and the remaining references fail to disclose or suggest each and every element of the rejected claims, as is acknowledged by the Examiner.

Regarding claim 272, the Examiner generally cites, in essence, the *entirety* of Avnet (citing col. 1, line 60 to col. 5, line 40) for disclosing “receiving a credit card in a card module of the self-service machine; accessing, using a communication device, an account associated with the credit card; deducting a specified amount from a line of credit associated with said credit card; and adding to said total value of the bulk coins the specified amount prior to the act of dispensing the card having the storage medium for storing the monetary value that is related to

said total value”. In setting forth an alleged *prima facie* case, the Examiner is required to point to “page and line” of a reference wherein each feature of a claimed invention is asserted to reside. *See, e.g., In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). The Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is not met and “examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *See Id.*; *see also Fregeau v. Mossinghoff*, 776 F.2d 1034, 227 USPQ 848 (Fed. Cir. 1985); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). The *prima facie* showing must be set forth in a well-reasoned statement. Mere citation to a reference fails to discharge this burden and reconsideration and withdrawal is requested for at least this reason as well as a *prima facie* case has not been set forth.

The Examiner’s factually and legally insufficient allegations aside, Avnet fails to make up for the deficiencies of the combination of Molbak, Small, and Geib and fails to disclose or suggest “selecting a card from a plurality of cards that are not associated with any value; storing on a storage medium of said card a monetary value that is related to said total value; and dispensing said card from the self-service machine.” Instead, Avent relates to businesses and institutions that “provide food to their employees and guests” that may be purchased from their own vending machines (col. 1, lines 23-30)(not cited by Examiner). Avent discloses only the vending of a single, specific-use card for use with a particular vending machine or group of vending machines.

Reconsideration and withdrawal of this 35 U.S.C. § 103 rejection is requested for at least the above-noted reasons.

5. 35 U.S.C. § 103 REJECTION OF CLAIM 273

Claim 273 is rejected under 35 U.S.C. 103(a) as being unpatentable over Molbak et al. (US 5620079) in view of Small (US 5513117) in further view of Geib et al. (US 6042470) in further view of Mays et al. (US 5547062) in further view of Ramsey et al. (US 5842188). Reconsideration and withdrawal of this rejection is respectfully requested for at least the reasons noted above with regard to claims 271, 275 and 278. The balance of the cited references has not been shown to make up, *inter alia*, for the noted deficiencies of Molbak and Small.

As an initial matter, Applicants respectfully submit that Geib is an inappropriate reference for combination with Molbak and Small, as alleged. Under 35 U.S.C. § 103(c)(1), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, ***shall not preclude patentability under this section*** where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person”. (emphasis added). Geib is assigned to Cummins-Allison Corp., the present assignee, and the Examiner has not shown that Geib is a 35 U.S.C. § 102(a) or 35 U.S.C. § 102(b) reference. Instead, the filing date of Geib was April 18, 1997, with a claimed priority of January 11, 1996. The present application is a divisional of and claims priority to U.S. Application No. 08/814,978, filed March 11, 1997, which claims priority to U.S. Provisional Application Nos. 60/031,604 (filed November 27, 1996), and is a continuation-in-part of U.S. Application No. 08/664,262, filed May 13, 1996. Accordingly, the proffered

rejection fails to set forth a *prima facie* case of obviousness for at least the reason that Geib is an inappropriate reference to apply in combination with the remaining references and the remaining references fail to disclose or suggest each and every element of the rejected claims, as is acknowledged by the Examiner.

Neither Mays nor Ramsey make up for the deficiencies of the combination of Molbak and Small (or Molbak, Small and Geib for that matter) and the Examiner has not set forth a *prima facie* case supporting the obviousness of such combination.

6. 35 U.S.C. § 103 REJECTION OF CLAIM 274

Claim 274 is rejected under 35 U.S.C. 103(a) as being unpatentable over Molbak et al. (US 5620079) in view of Small (US 5513117) in further view of Geib et al. (US 6042470) in further view of Avnet et al. (US 5291003) in further view of Mays et al. (US 5547062) in further view of Ramsey et al. (US 5842188). Reconsideration and withdrawal of this rejection is respectfully requested for at least the reasons noted above with regard to claims 271, 275 and 278. The balance of the cited references has not been shown to make up, *inter alia*, for the noted deficiencies of Molbak and Small.

As an initial matter, Applicants respectfully submit that Geib is an inappropriate reference for combination with Molbak and Small, as alleged. Under 35 U.S.C. § 103(c)(1), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, ***shall not preclude patentability under this section*** where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person”. (emphasis added). Geib is assigned to Cummins-Allison Corp.,

the present assignee, and the Examiner has not shown that Geib is a 35 U.S.C. § 102(a) or 35 U.S.C. § 102(b) reference. Instead, the filing date of Geib was April 18, 1997, with a claimed priority of January 11, 1996. The present application is a divisional of and claims priority to U.S. Application No. 08/814,978, filed March 11, 1997, which claims priority to U.S. Provisional Application Nos. 60/031,604 (filed November 27, 1996), and is a continuation-in-part of U.S. Application No. 08/664,262, filed May 13, 1996. Accordingly, the proffered rejection fails to set forth a *prima facie* case of obviousness for at least the reason that Geib is an inappropriate reference to apply in combination with the remaining references and the remaining references fail to disclose or suggest each and every element of the rejected claims, as is acknowledged by the Examiner.

At least for the reasons noted above, the combination fails to reasonably disclose or suggest all of the claim elements and the Examiner has not set forth a *prima facie* case supporting the obviousness of such combination.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the number indicated.

It is noted that only portions of the Examiner's assertions are discussed above. Applicant's traverse the Examiner's rejection, in its entirety, and do not agree with the stated facts or conclusions therein. For brevity, only particular aspects of the rejections have been noted herein, which is not to be misconstrued as agreeing with any of the asserted facts, alleged evidence, or asserted conclusions.

The Applicants submit that the claims are in a condition for allowance and action toward that end is earnestly solicited.

It is believed that, beyond the extension of time fee, no additional fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247171-000373USD1.

Respectfully submitted,

April 11, 2011

Date

/William D. PEGG, Reg. No. 42,988/

William D. Pegg

Reg. No. 42,988

Nixon Peabody LLP

300 S. Riverside Plaza, 16th Floor

Chicago, IL 60606

(312) 425-3900 – Telephone

(312) 425-3909 – Facsimile

Attorneys for Applicants